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EXAMINER

FOX, BRYAN J

ART UNIT PAPER NUMBER

2617

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/082,831

Applicant(s)

RITTER, RUDOLF

Examiner

Bryan J. Fox

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-73 is/are pending in the application.
- 4a) Of the above claim(s) 3-19, 33-39, 41, 44-46 and 49-68 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 20-32, 40, 42, 43, 47, 48, 69-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 25, 2006 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 20, 21, 26-29, 31, 32, 40, 47 and 69-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ritter in view of Baba et al (EP000791901A2).

Regarding claim 69, Ritter discloses a receiving system has receiving means for receiving a media program sent out over a broadcast channel and program accompanying data, and reproduction means for playing the received media program back to the user (see page 11, lines 4-8), which reads on the claimed, "an order method for a user ordering at least one product or service of a provider, said method comprising the steps of: reproducing an offer for the product or service using electronic reproduction means of a personal terminal." If the mobile apparatus is switched on, the applet is directly displayed on the display and the user may order products (see page 11, lines 10-18), which reads on the claimed, "the user selecting the product or service using the personal terminal; transmitting, to the user terminal, an order parameter that is connected to the selected offer; executing, in said personal terminal, an order program with which order data can be entered." When a command is entered by a user, a message is prepared corresponding to the entered command, the message including at least one data field from the digital data received and an identification of the user determined from the identification card, and the prepared message is sent over a mobile radio network (see page 2a, lines 11-26), which reads on the claimed, "the user entering the order data into the entry mask; determining, from identification data identification data stored in a personal identification module of the personal terminal, user identity data for identifying the user; linking said entered order data with the user identity data; and transmitting an order message with said linked data to the provider via said remote server." Ritter fails to disclose the user terminal transmitting, to a remote server, product data about the selected product or service and the remote server transmitting,

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to the user terminal, an order parameter that is connected to the selected offer based on the data about the selected product or service and at least certain order parameters are used for adapting an entry mask displayed by the order program according to the selected offer.

In a similar field of endeavor, Baba et al disclose a system where a terminal of a card holder acquires beforehand merchandise information of a seller through communications between its own terminal 1 and a terminal 2 of the seller. When the card holder is going to buy desired merchandise from the seller, the card holder asks in advance the seller to send the data of an order form to the card holder. Then, using the order form, the card holder enters order data to purchase the desired merchandise through the terminal 1 (see column 6, lines 21-45), which reads on the claimed, "the user terminal transmitting, to a remote server, product data about the selected product or service; the remote server transmitting, to the user terminal, an order parameter that is connected to the selected offer based on the data about the selected product or service," and, "at least certain order parameters are used for adapting an entry mask displayed by the order program according to the selected offer."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Ritter with Baba et al to include the above terminal transmitting product data and remote server transmitting an order parameter connected to the offer and parameters used for adapting an order mask in order to facilitate a electronic commercial transaction in an electronic commerce system as suggested by Baba et al (see column 6, lines 3-20).

Regarding claim

Regarding claim 2, the combination of Ritter and Somoza et al discloses a message is received by means of a telecommunications mobile device (see Ritter page 2a, lines 11-26), which reads on the claimed, "said reproduced offer is transmitted by the provider over an electronic channel into said personal terminal."

Regarding claim 20, the combination of Ritter and Somoza et al discloses identification data is obtained from the identification card (see Ritter page 2a, lines 11-26), which reads on the claimed, "said identification module is a chip card."

Regarding claim 21, the combination of Ritter and Somoza et al discloses a user profile stored in the secured area of the SIM card (see Ritter column 7, lines 24-30), which reads on the claimed, "said identification data are stored in a secured area of the chip card."

Regarding claim 26, the combination of Ritter and Somoza et al discloses that the java applet is received by the SIM card in the mobile apparatus, which carries out the interactive process with the user (see Ritter page 7, lines 1-9), which reads on the claimed, "the order parameters are transmitted into said chip card."

Regarding claim 27, the combination of Ritter and Somoza et al discloses that the data fields may be signed in order to guarantee confidentiality (see Ritter page 9, lines 15-19), which reads on the claimed, "said transmitted parameters are signed

electronically, so that the terminal can verify the integrity and authenticity of these parameters.”

Regarding claim 28, the combination of Ritter and Somoza et al discloses that the desired product quantity may be selected (see Ritter page 9, lines 12-13), which reads on the claimed, “said order data comprise an ordered quantity.”

Regarding claim 29, the combination of Ritter and Somoza et al discloses that the preferred mode of payment can be selected (see Ritter page 9, lines 12-13), which reads on the claimed, “said order data comprise a billing method.”

Regarding claim 31, the combination of Ritter and Somoza et al discloses the user identification includes at least the full name and address of the subscriber (see Ritter page 5, lines 20-31), which reads on the claimed, “said order data comprise a delivery address.

Regarding claim 32, the combination of Ritter and Somoza et al disclose the subscriber data is in a subscriber database (see Ritter page 5, lines 20-31), which reads on the claimed, “said applet allows the selection of the delivery address from an available directory.”

Regarding claim 40, the combination of Ritter and Somoza et al discloses the order message is transmitted to the server, and the server combines the order number with user identification data from a subscriber database (see Ritter page 5, lines 20-31), which reads on the claimed, “said order message is first transmitted to the operator that has stored said identification data in said identification module, additional user identification data are read in a database managed by said operator, at least part of the

contents of said order message is linked with said additional user identification data.”

Further, the data combined in the server are sent to the logistics center of the supplier (see Ritter page 6, lines 13-17), which reads on the claimed, “the linked data are forwarded on.”

Regarding claim 47, the combination of Ritter and Somoza et al discloses the connection between the server 13 and the logistics center 12 is wired (see Ritter figure 1), which reads on the claimed, “said linked data are transmitted over a fixed network to said operator.”

Regarding claim 70, Ritter discloses a receiving system has receiving means for receiving a media program sent out over a broadcast channel and program accompanying data, and reproduction means for playing the received media program back to the user (see page 11, lines 4-8), which reads on the claimed, “an order method for a user ordering at least one product or service of a provider, said method comprising the steps of: reproducing an offer for the product or service using electronic reproduction means of a personal terminal.” If the mobile apparatus is switched on, the applet is directly displayed on the display and the user may order products (see page 11, lines 10-18), which reads on the claimed, “the user selecting the product or service using the personal terminal; transmitting, to the user terminal, an order parameter that is connected to the selected offer; executing, in said personal terminal, an order program with which order data can be entered.” When a command is entered by a user, a message is prepared corresponding to the entered command, the message including at least one data field from the digital data received and an identification of the user

determined from the identification card, and the prepared message is sent over a mobile radio network (see page 2a, lines 11-26), which reads on the claimed, "the user entering the order data into the entry mask; linking said entered order data with user identification data stored in a personal identification module of the personal terminal; and transmitting an order message with said linked data to the provider." Ritter fails to expressly disclose at least certain order parameters are used for adapting an entry mask displayed by the order program according to the selected offer.

In a similar field of endeavor, Somoza et al disclose when the user is finished selecting products, he can complete a customized order form for his selected products, and purchase the products using commercial retail methods (see column 7, lines 19-43).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Ritter with Somoza et al to include the above customized order form in order to create a user-friendly graphical user interface as suggested by Somoza et al (see column 5, lines 4-18).

Regarding claim 71, Ritter discloses a receiving system has receiving means for receiving a media program sent out over a broadcast channel and program accompanying data, and reproduction means for playing the received media program back to the user (see page 11, lines 4-8), which reads on the claimed, "system for a user ordering at least one product or service of a provider, said system comprising: means for reproducing an offer for the product or service using electronic reproduction means of a personal terminal." If the mobile apparatus is switched on, the applet is

directly displayed on the display and the user may order products (see page 11, lines 10-18), which reads on the claimed, "means for the user selecting the product or service using the personal terminal; means for transmitting, to the user terminal, an order parameter that is connected to the selected offer; means for executing, in said personal terminal, an order program with which order data can be entered." When a command is entered by a user, a message is prepared corresponding to the entered command, the message including at least one data field from the digital data received and an identification of the user determined from the identification card, and the prepared message is sent over a mobile radio network (see page 2a, lines 11-26), which reads on the claimed, "means for the user entering the order data into the entry mask; means for linking said entered order data with user identity identification data stored in a personal identification module of the personal terminal; and means for transmitting an order message with said linked data to the provider." Ritter fails to disclose the user terminal transmitting, to a remote server, product data about the selected product or service and the remote server transmitting, to the user terminal, an order parameter that is connected to the selected offer based on the data about the selected product or service and at least certain order parameters are used for adapting an entry mask displayed by the order program according to the selected offer.

In a similar field of endeavor, Baba et al disclose a system where a terminal of a card holder acquires beforehand merchandise information of a seller through communications between its own terminal 1 and a terminal 2 of the seller. When the card holder is going to buy desired merchandise from the seller, the card holder asks in

advance the seller to send the data of an order form to the card holder. Then, using the order form, the card holder enters order data to purchase the desired merchandise through the terminal 1 (see column 6, lines 21-45), which reads on the claimed, "means for the user terminal transmitting, to a remote server, product data about the selected product or service; means for the remote server transmitting, to the user terminal, an order parameter that is connected to the selected offer based on the data about the selected product or service," and, "at least certain order parameters are used for adapting an entry mask displayed by the order program according to the selected offer."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Ritter with Baba et al to include the above terminal transmitting product data and remote server transmitting an order parameter connected to the offer and parameters used for adapting an order mask in order to facilitate a electronic commercial transaction in an electronic commerce system as suggested by Baba et al (see column 6, lines 3-20).

Regarding claim 72, Ritter discloses a receiving system has receiving means for receiving a media program sent out over a broadcast channel and program accompanying data, and reproduction means for playing the received media program back to the user (see page 11, lines 4-8), which reads on the claimed, "an order method for a user ordering at least one product or service of a provider, said method comprising the steps of: a provider server transmitting an offer for the product or service using electronic reproduction means of a personal terminal." If the mobile apparatus is switched on, the applet is directly displayed on the display and the user may order

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products (see page 11, lines 10-18), which reads on the claimed, "the user selecting the product or service using the personal terminal," and, "transmitting, to the user terminal, said order parameter; executing, in said personal terminal, an order program with which order data can be entered." When a command is entered by a user, a message is prepared corresponding to the entered command, the message including at least one data field from the digital data received and an identification of the user determined from the identification card, and the prepared message is sent over a mobile radio network (see page 2a, lines 11-26), which reads on the claimed, "the user terminal transmitting, to the remote server, identification data stored in a secured area of a removable personal identification module of the personal terminal," and, "the user entering the order data into the entry mask," and, "said remote server determining, from identification data identification data stored in a personal identification module of the personal terminal, user identity data for identifying the user; and said remote server transmitting an order message with said linked data to the provider via said remote server." Further, the server 13 combines at least some of the information contained in the short message entered by the user with the user identifications in order to complete the identification of the user (see page 6, lines 9-11), which reads on the claimed, "said remote server linking said entered order data with user identification data stored in a secured area of a removable personal identification module of the personal terminal." The java applet is received by the SIM card and the SIM card has java capability (see page 7, lines 1-9), which reads on the claimed, "said order program is stored in the identification module." Ritter fails to disclose the user terminal transmitting, to a remote

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server, product data about the selected product or service and the remote server transmitting, to the user terminal, an order parameter that is connected to the selected offer based on the data about the selected product or service and at least certain order parameters are used for adapting an entry mask displayed by the order program according to the selected offer.

In a similar field of endeavor, Baba et al disclose a system where a terminal of a card holder acquires beforehand merchandise information of a seller through communications between its own terminal 1 and a terminal 2 of the seller. When the card holder is going to buy desired merchandise from the seller, the card holder asks in advance the seller to send the data of an order form to the card holder. Then, using the order form, the card holder enters order data to purchase the desired merchandise through the terminal 1 (see column 6, lines 21-45), which reads on the claimed, "the user terminal transmitting, to a remote server, product data about the selected product or service," and, "the remote server obtaining, from the provider server, an order parameter that is connected to the selected offer based on the data about the selected product or service," and, "at least certain order parameters are used for adapting an entry mask displayed by the order program according to the selected offer."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Ritter with Baba et al to include the above terminal transmitting product data and remote server transmitting an order parameter connected to the offer and parameters used for adapting an order mask in order to facilitate a electronic

commercial transaction in an electronic commerce system as suggested by Baba et al (see column 6, lines 3-20).

Regarding claim 73, the combination of Ritter and Baba et al disclose the java applet is received by the SIM card and the SIM card has java capability (see page 7, lines 1-9), which reads on the claimed, "said order program is executed by data processing means in said identification module."

Claims 19 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ritter in view of Baba et al as applied to claim 69, and further in view of Baumann (US006104922A).

Regarding claim 19, the combination of Ritter and Baba et al fails to expressly disclose the identity of the user is verified on the basis of biometric parameters.

In a similar field of endeavor, Baumann discloses the use of biometric data to identify a user (see figure 6), which reads on the claimed, "the identity of the user is verified on the basis of biometric parameters."

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Ritter and Baba et al with Baumann to include the above use of biometric data to identify a user in order to provide a better method to authenticate users that can never be lost or stolen as suggested by Baumann (see column 3, lines 20-25).

Regarding claim 22, the combination of Ritter, Baba et al and Baumann discloses a user identification means, preferably chip-card reading means, for identifying the user of the receiving system by means of an identification card (see Ritter page 6, lines 1-7)

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and the applet is received by the SIM card which carries out the interactive process with the user (see Ritter page 7, lines 1-9), which reads on the claimed, "said order program linked with the selected offer is executed by data processing means in said chip card."

Regarding claim 23, the combination of Ritter, Baba et al and Baumann discloses the applet is received by the SIM card which carries out the interactive process with the user (see Ritter page 7, lines 1-9), which reads on the claimed, "said order program is an applet."

Regarding claim 24, the combination of Ritter, Baba et al and Baumann discloses that the applet may be filed in a buffer on the SIM card (see Ritter page 11, lines 19-24), which reads on the claimed, "the applet is stored in the chip card during the personalization of the chip card."

Regarding claim 25, the combination of Ritter, Baba et al and Baumann discloses the applet is received over a broadcast channel (see Ritter page 11, lines 4-9), which reads on the claimed, "the applet is downloaded over a radio interface."

Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ritter in view of Baba et al as applied to claim 26 above, and further in view of Goldstein (US005410326A).

Regarding claim 30, the combination of Ritter and Baba et al discloses providing the deliver address, however, the combination of Ritter and Baba et al fails to expressly disclose the order data comprise the delivery method.

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In a similar field of endeavor, Goldstein discloses providing a delivery method (see column 31, lines 1-10).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Ritter and Baba et al with Goldstein to include the above providing a delivery method in order to provide a vendor with all necessary instructions as suggested by Goldstein (see column 29, lines 16-29).

Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ritter in view of Baba et al as applied to claim 40 above, and further in view of Crosby et al (US006628928B1).

Regarding claim 43, the combination of Ritter and Baba et al fails to expressly disclose the order message is transmitted to a provider address read in a provider address database.

In a similar field of endeavor, Crosby et al disclose retrieving a vendor address from a database (see column 10, lines 7-29).

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Ritter and Baba et al with Crosby et al to include the above vendor address database in order to save space at the mobile station.

Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ritter in view of Baba et al. as applied to claim 47 above, and further in view of Yurino et al (US006810386B1).

Regarding claim 48, the combination of Ritter and Baba et al fails to expressly disclose a plurality of said liked data of a plurality of users are transmitted simultaneously to said provider.

In a similar field of endeavor, Yurino et al disclose a system where simultaneous information from a plurality of subscribers is received (see, e.g. column 2, lines 20-28)

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify the combination of Ritter and Baba et al with Yurino et al to include the above reception of information from a plurality of users simultaneously in order to increase the capacity of the system.

Response to Arguments

Applicant's arguments with respect to claims 2-73 have been considered but are moot in view of the new ground(s) of rejection.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J. Fox whose telephone number is (571) 272-7908. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Bryan Fox
December 8, 2006



CHARLES APPIAH
PRIMARY EXAMINER